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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/534,833 | 05/13/2005 | Stefano Cerbini | 2563-1001 | 8979 |
| <div>466 7590 09/03/2010</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div> | | | | |
| EXAMINER | | | | |
| CHOL PETER Y | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1786 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 09/03/2010 | | ELECTRONIC | | |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFANO CERBINI and PASQUALINO LO IOCO

Appeal 2009-014153
Application 10/534,833
Technology Center 1700

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL¹

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 15-21 and 26-36. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants' invention relates to clothing suitable for protection against biological agents (Spec. 1:4-5). Claim 15 is illustrative:

15. Protective clothing against biological agents and exhibiting very high level of protection against the penetration of liquids and microorganisms, mechanical resistance properties as well as outstanding softness, drapeability and comfort, comprising:

a laminate of an inner layer of non-woven polypropylene with an outer layer of polyethylene film, a unit weight ratio between polypropylene and polyethylene ranging from 70:30 to 50:50.

The Examiner relies upon the following evidence:

| <u>First Named Inventor</u> | <u>Document No.</u> | <u>Issue or Pub. Date</u> |
|-----------------------------|---------------------|---------------------------|
| Bodford | US 5,589,249 | Dec. 31, 1996 |
| McCormack | US 5,855,999 | Jan. 5, 1999 |
| Wu | US 5,865,926 | Feb. 2, 1999 |
| Langley | EP 0 360 208 | Mar. 28, 1990 |

The Examiner maintains, and Appellants seek review of, the following rejections:

1. The rejection of claims 15-20 and 26-35 under 35 U.S.C. § 102(b) as anticipated by, or alternatively under 35 U.S.C. § 103(a) as obvious over, Bodford;
2. The rejection of claims 21 and 36 under 35 U.S.C. § 103(a) as unpatentable over Bodford in view of Langley;
3. The rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over Wu in view of McCormack;
4. The rejection of claims 17-20 under 35 U.S.C. § 103(a) as unpatentable over Wu in view of McCormack and Bodford.

In addressing the issue on appeal, we focus our attention on rejections (1) and (2) based on Bodford, as rejections (3) and (4) based on Wu and McCormack are cumulative.

II. DISPOSITIVE ISSUE

The dispositive issue on appeal arising from the contentions of Appellants and the Examiner is: does the evidence support the Appellants' view that the Examiner erred in finding that Bodford teaches protective clothing with the claimed unit weight ratio and the claimed high level of protection and outstanding softness, drapeability and comfort, either expressly or inherently? We answer this question in the negative.

III. DISCUSSION

With respect to the first anticipation rejection, Appellants argue the claims as a group (Br. 12-13). Appellants make no arguments regarding the rejection of dependent claims 21 and 36 over and above those arguments directed to the independent claims from which they depend (Br. 18). Accordingly, we select independent claim 15 as a representative claim to decide the issue on appeal.

We adopt the Examiner's findings in the Answer as our own and add any additional findings of fact appearing below for emphasis.

Appellants contend that Bodford does not expressly teach a unit weight ratio between polypropylene and polyethylene and that the Examiner has improperly extracted a ratio from raw data, citing the reasoning in *Harries v. Air King Prods. Co., Inc.*, 183 F.2d 158 (2d Cir. 1950) (Br. 8-13).

The Examiner has provided calculations based on the teachings of Bodford to show that Bodford describes a composite cloth having a unit

weight ratio within the scope of the claimed ratio (Ans. 12-13), and thus argues that the claimed ratio is expressly taught and/or naturally flows from the teachings of Bodford (Ans. 14 and 16). The Examiner also argues that the holding of *Harries* does not support the premise that the Examiner cannot rely on a ratio that is inherent in a prior art reference (Ans. 14-15).

In general, a limitation is inherent if it is the “natural result flowing from” the explicit disclosure of the prior art. *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003). When the Examiner relies upon a theory of inherency, “the [E]xaminer must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis omitted).

The Examiner has provided sufficient factual evidence and detailed calculations (Ans. 13), to show that the claimed unit weight ratio naturally or necessarily flows from the teachings of Bodford. We fully agree with the Examiner that the claims are anticipated inherently by the teachings of Bodford.

When a claimed product appears to be substantially identical to a product disclosed by the prior art, the burden is on the applicants to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). On this record, Appellants have not refuted the Examiner’s calculations or factual findings or provided any further evidence to persuade us that the Examiner’s finding is untenable.

We also agree with the Examiner that Appellants' reliance on the holding of *Harries* is misplaced since the holding is not relevant to the facts currently at issue. In *Harries*, the issue was whether or not a claim, which did not literally recite a ratio, could have been interpreted to require a ratio, based on a later amendment to the specification adding such language. The Second Circuit held that the amendment to the specification constituted new matter that was not supported by the specification as originally filed, and thus, the claims could not have been interpreted more broadly than the literal claim language. See *Harries*, 183 F.2d at 159-161.

However, the present issue is not directed to claim interpretation or to a question of new matter in a specification. To the contrary, the present issue is limited to the Examiner's application of undisputed teachings within the prior art to show anticipation of a claimed article.

Moreover, in the case of *Harries*, only one of the elements of the electron stream length to cross-section ratio had sufficient support in the originally filed specification. *Harries*, 183 F.2d at 159 (original form of the specification did not once mention the ratio of the length of the electron stream to its cross-section, only the division of electron streams into non-deflectable short streams and deflectable streams of comparatively great length). In the present case, however, the Examiner has provided sufficient evidence that the prior art teaches a weight of both polypropylene and polyethylene, such that a unit weight ratio naturally or necessarily flows from the teachings.

Appellants also contend that the high level of protection and outstanding softness, drapeability, and comfort recited in the claims would not be obtained because Bedford utilizes an additional substrate (Br. 13).

In addition to making specific findings that Bodford teaches protection, softness, pliability and comfort (Ans. 16-17), the Examiner also notes that the claim terms are not objective or quantifiable characteristics, and argues that the claimed subjective characteristics are inherent in the substantially similar structure and composition taught by Bodford (Ans. 16-17). The Examiner also points out that the claims include open “comprising” language and encompass a structure further including an additional substrate as taught by Bodford (Ans. 17).

We agree with the Examiner’s claim interpretation, and we agree with the Examiner that based on the teachings of Bodford, the burden shifts to Appellants to show that the claimed characteristics are not inherent in the protective clothing taught by Bodford. *See Spada*, 911 F.2d at 708; *In re Best*, 562 F.2d at 1255.

Accordingly, we are not persuaded by Appellants’ arguments against the Examiner’s finding that the claims are anticipated by the teachings of Bodford.

IV. CONCLUSION

On the record before us and for the reasons discussed above, we sustain the rejections of claims 15-20 and 26-35 under 35 U.S.C. § 102(b) as anticipated by Bodford and of claims 21 and 36 under 35 U.S.C. § 103(a) as unpatentable over Bodford in view of Langley. Since we sustain the Examiner’s rejections based on Bodford, which addresses all of the pending claims, we decline to reach a decision on the cumulative rejections based on Wu and McCormack.

V. DECISION

The decision of the Examiner is affirmed.

VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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